

REMARKS

Claims 50-54 and 59-69 were pending in the application as examined. The present Amendment amends claim 53 to correct a typographical error and to provide consistency of claim language. Claims 50-51, 53-54 and 59-60 have also been amended to specify that the claimed golf clubs have a head with a *single* design loft. Support for this last amendment can be found throughout the application as filed and in particular in the Figures. No new matter is added by this Amendment.

In the Office Action, claims 51, 53-54 and 56-59 were rejected as being anticipated by Thompson (U.S. Patent No. 3,961,796) and for obviousness over Adams (U.S. Patent No. 5,971,866) in view of Hirose (U.S. Patent No. 5,564,991). Claims 50 and 52 were rejected for obviousness over either Thompson in view of Scheie (U.S. Patent No. 5,120,062), or Adams in view of Hirose and Scheie. These rejections are addressed below.

Thompson (alone or in view of Scheie)

The Examiner points to Fig. 2 of Thompson as depicting an iron-type club whose shaft forms a non-zero lean angle with the vertical when the head rests on its sole with its impact face positioned at its design loft. Applicant respectfully disagrees.

Thompson has five Figures, all of the same golf club head. The inventive features of this head, as described by Thompson, are its downwardly tapered keel and weight-receiving passage(s) between the keel and a hollow in the rear side of the head. Fig. 2 is said to be a toe end elevation of the head (Drawing Description, column 1, line 68). Other than this characterization, there is no specific description of Fig. 2 in Thompson. Furthermore, there is no discussion relating to *any* of the Figures that addresses the shaft/head connection. All we know is that the iron that is depicted "is intended to represent a wedge" (column 2, lines 15-16). Thus, those of ordinary skill in the art would understand that, other than its keel and weighting features, the depicted club is a *standard wedge*. As Applicant has previously documented through Declaratory and other evidence, a standard wedge has a zero lean angle (see, for example, ¶ 4, 6 and 11 of the Declaration by Mr. John Hampford, President and CEO of Hoffman Forged Products, that was filed on November 15, 2001). This evidence establishes that the claimed golf clubs, containing a lean angle, are a *radical* departure from the standard.

To the extent that the actual picture presented in Fig. 2 could be viewed as having a lean

angle (in hindsight after reading the present specification), those of ordinary skill in the art would have understood it to be merely an inaccurate representation of a standard club. There is no indication in Fig. 2, or anywhere else in Thompson, that the Figures are drawn to scale, or with angular precision. It is well established that unexplained features of a drawing must be evaluated for what they *reasonably* disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). Fig. 2 of Thompson would not reasonably disclose the claimed golf clubs to a person of ordinary skill in the art. The rejections over Thompson should be removed.

Scheie et al. also describes golf club heads whose unusual feature is their weighting; other aspects of the heads and clubs that incorporate them are standard. Thus no combination of Thompson with Scheie et al. could render obvious the present claims; this rejection should also be removed.

Adams (in view of Hirose alone or Hirose and Scheie)

The Examiner points to Figs. 3-5 of Adams as depicting an iron-type club whose shaft forms a non-zero lean angle with the vertical when the head rests on its sole with its impact face positioned at its design loft. Applicant respectfully disagrees. The heads of the presently claimed golf clubs have a single design loft which is in stark contrast with the clubs of Adams (see Figs. 3-5). The golf clubs of Adams are designed to overcome the limitations of golf clubs with single design lofts and Adams even explicitly *teaches away* from such golf clubs (see, column 1, lines 29-40):

“Normally the sole or bottom surface of a golf club is designed to lie flat on the ground surface to position the club face at a predetermined face loft angle. A golfer may manipulate the club face of a particular lofted club to alter the loft face angle, however this results in the sole of the club head being angled, that is not flat, with respect to the ground surface. To enable a golf club to be used for a number of different loft angles, golf clubs with multiple uses have been developed having a plurality of ground engaging surfaces, each with different angular configurations whereby a single golf club may functionally take the place of two or more golf clubs with different lofts.”

Hirose is relied on to teach a limitation that is only present in a dependent claim (single

straight shaft) and does not remedy the deficiencies of Adams. Scheie is also relied on to teach a limitation that is only present in a dependent claim (the head and hosel being forged or cast) and does not remedy the deficiencies of Adams. Withdrawal of the rejection is respectfully requested.

Ahn and Solheim

The Examiner cites but does not rely on Ahn (U.S. Patent No. 6,015,354) and Solheim (U.S. Patent No. 5,564,991) as prior art. More specifically, the Examiner points to Fig. 9 of Ahn and Fig. 6 of Solheim.

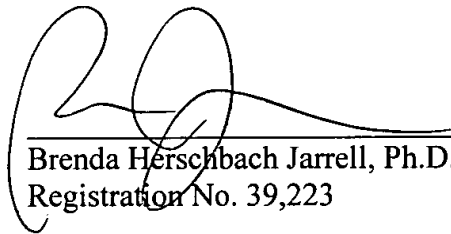
Ahn describes golf clubs that include a means for increasing, decreasing or adjusting the position and amount of weights in a golf club head (e.g., see Abstract). Ahn does not discuss the design loft or bounce of the golf club heads, nor does Ahn discuss the concepts of effective loft and lean angle. There is no teaching or suggestion in Ahn of the claimed golf clubs. The inventive feature of Ahn is the adjustable weight of the golf club heads; those of ordinary skill in the art would understand other aspects of the depicted clubs to be conventional. As discussed above, Applicant has already established that a lean angle represents a *radical* departure from the conventional (both at the time Ahn was filed and today). Thus, as with Thompson, to the extent that Fig. 9 of Ahn could be construed to represent a club with a lean angle, those of ordinary skill in the art would understand it to be an inaccurate representation of a standard club. ○

In Solheim, we are explicitly taught that the club of Fig. 6 (or Fig. 3 or 5) has a zero lean angle. Indeed, the lean angle is the angle measured between the shaft and the vertical *when the head rests on its sole so that its face achieves its design loft*. Figs. 3, 5 and 6 of Solheim show a club that has a vertical shaft (i.e., zero lean angle) when the head rests on its sole so that its face achieves its design loft (the design loft is labeled angle "A" in Figs. 3, 5 and 6, see lines 24-26, column 3). Further, the club heads that are taught by Solheim have bent hosels in contrast with the presently claimed clubs that include club heads with *straight* hosels.

CONCLUSION

Based on the arguments presented above, it is submitted that the pending claims, as amended herein, are allowable over the art of record. A Notice to that effect is respectfully requested. It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required for consideration of this paper (including fees for net addition of claims) are authorized to be charged to our Deposit Account No. 03-1721.

Respectfully submitted,



Brenda Herschbach Jarrell, Ph.D.
Registration No. 39,223

CHOATE, HALL & STEWART
Exchange Place
53 State Street
Boston, MA 02109
(617) 248-5000

Dated: August 8, 2003

3585239_1.DOC